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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,692	03/27/2006	Pascale Lacan	ESSR:111US/10603706	7189
32425	7590	08/19/2010	EXAMINER	
FULBRIGHT & JAWORSKI L.L.P. 600 CONGRESS AVE. SUITE 2400 AUSTIN, TX 78701			ROBINSON, ELIZABETH A	
			ART UNIT	PAPER NUMBER
			1787	
			NOTIFICATION DATE	DELIVERY MODE
			08/19/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

aopatent@fulbright.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/573,692	LACAN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Elizabeth Robinson	1787	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 21 May 2010.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 19-34 and 36-46 is/are pending in the application.  
 4a) Of the above claim(s) 23,24 and 44 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 19-22,25-34,36-43,45 and 46 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|  | 6) <input type="checkbox"/> Other: _____ .                        |

## DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 19-22, 25-34, 36-43, 45 and 46 are currently being examined.

### *Specification*

The amendments to the specification are approved.

### *Claim Rejections - 35 USC § 112*

**Claims 19-22, 25-34, 36-43, 45 and 46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

The term "amount that provides sufficient adhesion of the lens to a holding pad" in claim 19 is a relative term which renders the claim indefinite. The term "amount that provides sufficient adhesion of the lens to a holding pad" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. There is no indication of how much of the surface must be covered or what degree of adhesion (providing some adhesion versus providing all adhesion) is required in order to meet the limitations of claims 19. All other claims depend from claim 19 and thus, are also rendered indefinite.

Regarding claim 45, it is unclear what the offset is referring to. There is no teaching of what this offset is measured from or if the offset is some sort of rotational or translational movement.

Regarding claim 46, it is unclear what is meant by the center part of the temporary coating (center of a weighted average of the coating, anywhere away from the edge, etc.).

***Claim Rejections - 35 USC § 102***

**Claims 19, 20, 33, 34, 36 and 46 are rejected under 35 U.S.C. 102(b) as being anticipated by Ohlin (US 5,792,537).**

Regarding claims 19 and 20, Ohlin teaches an optical lens with a marking formed from a removable ink (protective coating that has an outer layer that is mechanically alterable through friction and/or contact) formed on the lens surface and then covered with a removable mask (Ohlin, claim 1). The preferred material for the mask is a static cling vinyl (Column 6, lines 33-45). The marking ink remains on the surface and then the lens is edged (Column 6, lines 4-12). Since the process of edging a lens uses a holding pad and the ink remains on the surface during the edging process, the amount of ink present allows the lens to have sufficient adhesion to the holding pad.

Regarding claims 33, 34 and 36, Ohlin (Column 6, lines 33-45) teaches that the plastic material film is preferably a polyvinyl chloride film that contains 49 to 57 percent plasticizer.

Regarding claim 46, the removable mask (peelable film) covers the marking ink (temporary protective coating) and thus, it covers the center part of the temporary protective coating.

***Claim Rejections - 35 USC § 103***

**Claims 19-22, 25-32, 38-43, 45 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conte et al. (WO 03/057641) in view of Lipman (US 5,451,281).**

Regarding claims 19-22, 25 and 26, Conte (Page 3, line 29 through Page 4, line 6) teaches an ophthalmic lens comprising a temporary protective layer. The temporary protective layer can be formed from MgF<sub>2</sub> (Page 6, lines 16-24). The temporary protective layer can be removed by dry wiping (Page 10, lines 25-29). For the trimming (edging) operation, the temporary protective layer is present in order to contact the self adhesive chip or double sided adhesive attached to a lens holding means (Page 8, lines 18-34). The temporary protective layer provides good adherence to the lens holding pad during the trimming (edging) operation (Page 8, line 18 through Page 9, line 9).

Conte does not teach coating the protective layer with a peelable film.

Lipman (Column 2, lines 49-66 and Figures 1-4) teaches a protective film 1 that imparts scratch resistance to a lens during the edging operation with an opening that allows attachment of the mounting block to the lens. The protective film 1 (Column 4, lines 37-68) can be a film with cling properties (electrostatically adhering). This film is releasably adhered to the lens (Column 6, lines 15-33) and thus, is peelable.

It would be obvious to one of ordinary skill in the art to use the protective film of Lipman, over the coated lens of Conte, in order to ensure that the surface of the lens is protected during the edging operation. The opening in the film of Lipman allows the coating of Conte to provide its adhesion function while still protecting the rest of the lens surface.

Regarding claim 27, Conte (Page 6, lines 3-5) teaches that the inorganic (mineral) protective layer has a preferable thickness of 5 to 200 nm.

Regarding claim 28, Conte (Page 8, lines 31-34) teaches that the protective layer has a surface energy of at least 15 mJoules/m<sup>2</sup>.

Regarding claims 29 and 30, Conte (Page 6, lines 1 and 2) teaches that the protective layer is preferably continuous.

Regarding claim 31, Conte (Page 6, lines 32 and 33) teaches that the temporary protective layer can have multiple layers.

Regarding claim 32, Conte (Page 7, lines 20-22) teaches that the protective layer can be formed by vapor phase deposition.

Regarding claim 38, Conte (Page 6, lines 16-19) teaches that the protective layer is coated on a hydrophobic and/or oleophobic surface coating.

Regarding claims 39 and 40, Conte (Page 4, lines 29-34) teaches that the hydrophobic and/or oleophobic surface coating preferable has a surface energy lower than 12 mJoules/m<sup>2</sup>.

Regarding claims 41 and 42, Conte (Page 5, lines 17-22) teaches that the hydrophobic and/or oleophobic surface coating preferably has a thickness from 2 to 5 nm.

Regarding claim 43, Conte (Page 4, line 25-28) teaches that the hydrophobic and/or oleophobic surface coating is generally applied to lenses comprising an antireflecting coating.

Regarding claim 45, the temporary protective coating of Conte can be formed of the same materials and in the same manner as in the instant application. As stated above, the temporary protective layer provides good adherence to the lens holding pad during the trimming (edging) operation. Since the temporary protective coating of Conte can be the same as that of the instant application and provides the same adherence during edging, the lens of Conte would undergo the same offset as in the instant application and meet the offset limitation.

Regarding claim 46, the film of Lipman (Column 6, lines 40-55) can be adhered to the lens and then the center portion can be removed. Prior to removal, the film, would cover the entire lens including the center portion of the temporary protective coating. After removal, the film still covers sections of the temporary protective coating away from the edge and this can be considered to be a center part of the temporary protective coating.

**Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ohlin (US 5,792,537) in view of Mascarenhas et al. (US 5,888,615).**

Regarding claim 37, as stated above, Ohlin teaches a lens that meets the limitations of claim 19 and states that it is preferred that the plastic material film is a polyvinyl chloride cling film.

Ohlin does not explicitly state the thickness of the film.

Mascarenhas (Column 2, lines 1-15) teaches that most cling films are vinyl chloride films that comprise 50-55 weight % plasticizer and have thicknesses from about 0.004 to 0.014 inches (101 to 355 microns).

The thickness of the film of Ohlin either meets the thickness limitation of the instant claim, since this is a standard thickness for these sheets or it would be obvious to one of ordinary skill in the art to use a film with a thickness that has been shown to be effective for cling films as taught by Mascarenhas.

### ***Response to Arguments***

Applicant's arguments filed May 21, 2010 have been fully considered but they are not persuasive.

Applicant argues that the Examiner stated in an interview that if claim 19 were revised to state that the temporary layer covers the surface of the lens in such an amount that provides sufficient adhesion of the lens to a holding pad during edging of the lens, then the anticipation rejection over Ohlin (US 5,792,537) would likely be removed. However, what was discussed in the informal interview was that if a

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quantifiable adhesion provided by the temporary protective layer and supported by the specification was added to the independent claim then, the anticipation rejection of record would possibly be overcome.

There is no claimed quantifiable adhesion that is required, only that it is sufficient. Given that the process of edging a lens uses a holding pad and the ink of Ohlin remains on the surface during the edging process, the amount of ink present allows the lens to have sufficient adhesion to the holding pad. Thus, the rejection in view of Ohlin is maintained. It is noted that marking ink is one of the temporary protective coatings of claim 20.

Applicant argues that one of ordinary skill in the art would not add the film of Lipman (US 5,451,281) to the lens of Conte et al. (WO 03/057641), since the film of Conte already has a protective coating. However, while Conte teaches good mechanical protection, if the lens has inorganic and organic layers, there is no teaching against providing additional protective materials that would provide additional protection for the lens. Since the lens requires protection, additional protection would help to ensure that the lens is not damaged due to scratching.

Applicant further provided a declaration stating that the temporary protective layer of Conte is sufficient to protect the lens. However, the declaration under 37 CFR 1.132 filed May 21, 2010 is insufficient to overcome the rejection of Claims 19-22, 25-32 and 38-43 based upon 35 U.S.C. 103(a) as being unpatentable over Conte et al. (WO 03/057641) in view of Lipman (US 5,451,281) as set forth in the last Office action because: Applicant states that there is no reason to add an additional protective

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coating to the lens during the edging process, since there is already the protective layer of Conte. However, Applicant provides no data to show that the additional protective layer of Lipman would not provide any additional protection to the lens.

Applicant argues that if the protective layer of Conte is too thick, the underlying functional layer would be damaged. However, the teaching is directed to keeping a single inorganic layer from getting too thick and causing stresses within that layer. This does not teach that an additional cling protective layer would cause stresses in either the inorganic or underlying functional layers

Applicant argues that the film of Lipman does not cover the center part of the temporary protective coating. However, as stated above, the film of Lipman (Column 6, lines 40-55) can be adhered to the lens and then the center portion can be removed.

Applicant argues that if the center portion of the lens of Conte is not covered, the coating on the lens would be damaged during storage, handling and transportation of the lens. However, there is no claim language that suggests that the lens must go through these steps prior to edging. It is further noted that the temporary coating of Conte can be the same as in the instant application. If this coating is so easily damaged, this appears to refute Applicant's earlier arguments that the temporary protective coating is so strong that no other layers would ever be necessary to protect the lens during edging.

Applicant's arguments over the 35 U.S.C. 102(b) rejection of claim 19 over Lipman are persuasive, due to Applicant's definition of the term "mechanically alterable" in the instant specification. Thus, this rejection is withdrawn. The rejections of claims

33-36 over Lipman in view of Ohlin and Claim 37 over Lipman in view of Mascarenhas et al. (US 5,888,615) are also withdrawn.

Due to amendments to the claims, the 35 U.S.C. 112, first paragraph rejections from the December 23, 2010 Office Action are withdrawn.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Robinson whose telephone number is (571)272-7129. The examiner can normally be reached on Monday- Friday 8 AM to 4:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/E. R./  
Elizabeth Robinson  
Examiner, Art Unit 1787

August 11, 2010

/Callie E. Shosho/  
Supervisory Patent Examiner, Art Unit 1787